



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 7

NEAL M COHEN
2424 SE BRISTOL STREET
SUITE 300
NEWPORT BEACH, CA 92660

COPY MAILED

APR 17 2003

OFFICE OF PETITIONS

In re Application of
Thomas C. Amon ET AL.
Application No. 10/001,761
Filed: October 31, 2001
Attorney Docket No. EVU-02-PUSA

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.182 or alternatively 37 CFR 1.183 filed September 9, 2002, to reinstate the application and the petition filed 37 CFR 1.137(b) and alternatively 37 CFR 1.137(b) filed February 10, 2003, to revive the above-identified application.

The petition under 37 CFR 1.182 is **DISMISSED**.

The petition under 37 CFR 1.183 is **DISMISSED**.

The petition under 37 CFR 1.137 (a) is **DISMISSED**.

The petition under 37 CFR 1.137 (b) is **GRANTED**.

The above-identified application became abandoned for failure to respond in a timely manner to the requirements set forth in the Notice To File Corrected Application Papers mailed December 20, 2001, which set a period for reply of two (2) months from its mailing date. The application became abandoned on February 21, 2002.

THE PETITION UNDER 37 CFR 1.182

It is not appropriate for petitioner to seek relief under 37 CFR 1.182 in that 37 CFR 1.182 is directed toward situations not provided for by the regulations. Situations which require either the withdrawal of the holding of abandonment, waiving of a rule, or revival of an abandoned application are provided for in 37 CFR 1.181 (a), 1.183, 1.137 (a) and 1.137 (b) respectively. Accordingly, the petition under 37 CFR 1.182 is immaterial to the issue.

THE PETITION UNDER 37 CFR 1.183

Petitioner has requested that the application be reinstated 37 CFR 1.183. However, the instant petition under 37 CFR 1.183 is being considered to be a request for the Commissioner to waive the time period as set for in the Notice to File Corrected Application Papers mailed December 21, 2001. 37 CFR 1.183 states

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

The circumstances of this case are not deemed to be so extraordinary that "justice requires" waiver of the time period, in that the Petitioner states that the Notice to File Corrected Application Paper ("Notice") was not received because it was mailed to the previous attorney of record, Kit M. Stetina, at the law firm Stetina, Brunda, Garred, & Bruckner ("Stetina"). During the set time period of response, counsel at Stetina had power of attorney in the instant application as petitioner did not file a revocation and power of attorney in the instant application until July 22, 2002. The power of attorney filed in the parent application on March 12, 2002, would not have an effect on the child application, because a separate power of attorney must be filed in each application, see 37 CFR 1.4 (b), where it states "Since each file must be complete in itself, a separate copy of every paper to be filed in a patent or trademark application, patent file, trademark registration file, or other proceeding must be furnished for each file to which the paper pertains, even though the contents of the papers filed in two or more files may be identical." Although petitioner sought the status of the application during this time period, no information regarding the application would have been provided to them beyond that which is available to the public (see 37 CFR 1.14). Since the attorney of record Kit M. Stetina received the "Notice," there is no doubt that applicant, via counsel, had received adequate notice of the defect in the application, and likewise had adequate time within which to reply, or seek extension of that period under the provisions of 37 CFR 1.136(a) as set forth in the Notice. Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable due care and diligence. See U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983). Under these circumstances petitioner has not shown that it is appropriate for the Commissioner to waive the two (2) period of response and, as such, the petition under 37 CFR 1.183 is dismissed.

WITH RESPECT TO THE PETITION UNDER 37 CFR 1.137(a):

An application is "unavoidably" abandoned only where petitioner takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Manifestly, as there is no showing that any action whatsoever was taken upon former counsel's receipt of the Office communication during the period for reply, the abandonment and resulting delay is not unavoidable. There is no showing that, upon receipt, the Office communication was docketed for timely reply in a reliable docketing system as would be employed by a prudent and careful person with respect to that person's most important business. See *In re Katrapat*, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988). Furthermore, there is no adequate showing that former counsel was "unavoidably" prevented from discharging his obligation to petitioner or that former counsel was "unavoidably" prevented from advising petitioner that counsel was unable to or otherwise would not reply and that petitioner should make other arrangements for continuing prosecution. Petitioner is reminded that the United States Patent and Trademark Office must

rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992). Specifically, an applicant's delay caused by the mistakes or omissions of a voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133 and 37 CFR 1.137(a). Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981), Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). While petitioner complains that current counsel was unable to obtain information regarding this application from the USPTO, such was properly refused absent the presentation of a proper power of attorney or of inspection, and it has not been shown that the presentation of an appropriate document was "unavoidably" delayed.

WITH RESPECT TO THE PETITION UNDER 37 CFR 1.137(b):

The petition is granted, and this application is restored to pending status.

Deposit Account 50-1105 has been charged \$130 for the petition for extraordinary relief, \$650 for the petition under 37 CFR 1.137(b), and \$55 for the petition under 37 CFR 1.137(a).

This application is being forwarded to the Office of Initial Patent Examination.

Telephone inquiries concerning this decision should be directed to Gregory J. Toatley, Jr. at (703) 305-4066 or to the undersigned at (703) 305-1820.



Brian Hearn
Office of Petitions
Office of the Deputy Commissioner
For Patent Examination Policy